

AMENDMENTS TO THE DRAWINGS:

The attached sheets of drawings include amended Figures A, D, E, F in order to improve clarity and/or better define the claimed invention.

Attachment: Replacement Sheets: 3 sheets – amended Figures A, D, E, F

REMARKS

Applicants respectfully acknowledge receipt of the Final Office Action mailed June 1, 2005.

In the Final Office Action, the Examiner: (1) rejected claims 1, 10, and 13 under 35 U.S.C. § 103(a) as being unpatentable over *Arndt et al.* (U.S. Patent No. 6,459,130) in view of *Hori* (U.S. Patent No. 6,469,398); (2) rejected claims 11 and 12 under 35 U.S.C. § 103(a) as being unpatentable over *Arndt* in view of *Hori*, and further in view of *Hurt et al.* (U.S. Publication No. 2003/0007749); and (3) rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Arndt* in view of *Hori*, and further in view of *Kwon et al.* (U.S. Patent No. 6,518,660).

By this Reply, Applicants amend Figures A, D, E, and F to improve clarity and/or better define the claimed invention. Claims 1 and 10-14 remain pending. Of these claims, claim 1 is independent.

Applicants respectfully traverse the Examiner's rejections for at least the reasons discussed below.

I. 35 U.S.C. § 103(a) REJECTION

Applicants respectfully submit that claims 1 and 10-14 are patentably distinguishable over *Arndt*, *Hori*, *Hurt*, *Kwon*, and the other art of record, at least for the reasons described below.

Applicants note that in order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. Second, there must be some suggestion or motivation, either in

the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must "be found in the prior art, and not be based on applicant's disclosure." See M.P.E.P. §2143, 8th ed., February 2003.

With respect to independent claim 1, the cited prior art fails to disclose or suggest each element of the invention. In particular, the applied references, taken alone or in combination, at least fail to teach or suggest an optoelectronic component based on a surface mount technology, said optoelectronic component comprising: an electrically conductive frame to form a base for an assembly; at least one optoelectronic chip mounted on said base; an electrical connection between said optoelectronic chip and said electrically conductive frame by wiring means; and soldering terminals which are part of said electrically conductive frame and are exposed at bottom and side portions of said component; wherein said electrically conductive frame is encapsulated with a translucent material to enable optical radiation to be transmitted or received via said optoelectronic component; and wherein said soldering terminals do not extend beyond an outline of said encapsulation material.

Arndt teaches a semiconductor component comprising a semiconductor chip 1 and external connections 11 and 12, which project outside a parallelepipedal encapsulation 3. (*Arndt*, col. 2, ll. 46-50 and Figs. 1A-1C). The parallelepipedal encapsulation 3 is produced in two parts from a radiation-impermeable base body 7 having a recess 8 and a radiation-permeable window part 9 which fills up recess 8 (emphasis added). (*Id.* at col. 3, ll. 4-7). *Arndt*, however, is silent as to having the entire

electrically conductive frame enclosed and encased within a translucent material, as this is an inherent and intrinsic characteristic of having an object encapsulated in a material (emphases added). (*Arndt*, Fig. A and *The American Heritage Dictionary*). Accordingly, *Arndt* necessarily fails to teach or suggest the claimed combination including “wherein said electrically conductive frame is encapsulated with a translucent material to enable optical radiation to be transmitted or received via said optoelectronic component” and “wherein said soldering terminals do not extend beyond an outline of said encapsulation material,” as recited in claim 1.

Thus, in order to cure the deficiencies of *Arndt*, the Examiner relies on *Hori* for its asserted disclosure of “soldering terminals (11 and 12) that do not extend beyond an outline of the encapsulation material (5).” (*Office Action*, p. 2, ll. 22-24). Applicants note, however, that *Hori* does not teach or suggest, among other things, “wherein said electrically conductive frame is encapsulated with a translucent material to enable optical radiation to be transmitted or received via said optoelectronic component,” as recited in claim 1. Consequently, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. §103(a) be withdrawn.

Moreover, claims 10-14 are allowable at least due to their dependence from claim 1.

II. CONCLUSION

In summary, Applicants submit that none of the cited references, including *Arndt*, *Hori*, *Hurt*, *Kwon*, and the other art of record, either alone or in any proper combination, teaches or suggests Applicants’ claimed invention.

Applicants respectfully request that this Reply be entered by the Examiner, placing claims 1 and 10-14 in condition for allowance. Because there are no proposed amendments to claims 1 and 10-14, this Reply should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the Final Office Action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of this Reply would allow Applicants to respond to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of this Reply would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of these remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Reply, the Examiner's reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: August 26, 2005

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Attachments: Amended Figures A, D, E, and F